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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 08/945,425      | 10/21/97    | CEDERBERG            | C 1103326-282       |

WHITE & CASE  
PATENT DEPARTMENT  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2787

HM12/0621

EXAMINER

DESAI, R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1625     | 13           |

DATE MAILED:

06/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Advisory Action

Application No.

08/945,425

Applicant(s)

Cederberg Christer et al

Examiner

Rita Desai

Group Art Unit

1625



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 3 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Jun 14, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☐ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
  - ☐ will not be entered because:
    - ☐ they raise new issues that would require further consideration and/or search. (See note below).
    - ☐ they raise the issue of new matter. (See note below).
    - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
    - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

- ☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: \_\_\_\_\_

Claims objected to: \_\_\_\_\_

Claims rejected: 1-11, 13, 19-21, 23, and 25

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

- ☐ Other

*Please see attachment.*

## **Attachment to the Advisory Action.**

Response to the letter received June 14th. 2000.

Cancellation of Claim 22 has been noted.

Election Restriction/Lack of Unity.

The Lack of Unity has been made Final in paper # 10, however, out of courtesy to the applicant examiner will respond to the arguments.

The lack of unity was made on the originally presented claims, drawn to the markush group.

----The only common core of the compounds is  $-S=O$ , which is not novel and is present in numerous compounds, used to treat different diseases.

----The claims presented originally, were in an independent form and had been searched already, in paper # 5. Thus lack of unity was done on independently presented claims and not on just the dependent claims.

The claims have been searched to the extent of the elected group 1, of the restriction/lack of unity presented in paper # 5.

Applicants claim that the blood plasma profile of the  $H^+$ ,  $K^+$ -ATPase inhibitors, (plasma membrane proton pump inhibitors) for the treatment of gastrointestinal disorders, is also not novel since there are numerous references which teach the proton pump inhibitors (ATPase inhibitors) and antisecretory activities. See Caplus 112:77040, 110:36608, 110:3408, 104:218442 are only some of the references.

Claims 1-11, 15, 16, 18 and 19 rejected under 35 USC 102 over Bergstrand US 5753265 of paper #5, still stands. See specifically claims 21 and 22 of the reference.

Claims 1-11, 15, 16, 18, 19 rejected under 35 USC 103 over Bergstrand US 5753265 and US 5717338 still stands. The reference discloses similar compounds used as PPI. These compounds are effective by increasing their half life in the blood plasma. The extended dose releases small portions, thus helping to extend the blood plasma profile. The rejection still stands.

The New rejections

Claims 1-11, 19-21, 23-25 rejected under 35 USC 102 over Bergstrand

US 5753265 still stands. All the claims (limited to the scope of the elected group 1) are addressed since the claims had been amended in the response after the previous rejection.

Claims 1-11, 19-21, 23, 25 rejected under 35 USC 103 over Bergstrand US 5753265 in view of Sachs et al, Remington Pharmaceutical science and, Scand .J. Gastroentero still stand.

Making layer tablets of different materials, soluble /insoluble is known to one skilled in the art, and one motivated to make extended blood profile formulations would have been motivated to do so since there is a reasonable expectation of obtaining this from the references mentioned above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Desai whose telephone number is (703) -305-1868. The examiner can normally be reached on Monday to Friday from 8.00 am to 4.30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the supervisor, Mr. John Knight, can be reached on (703) 308-0204.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1235 .

R.D.

June 19th. 2000.

*Alan L. Rotman*

ALAN L. ROTMAN  
PRIMARY EXAMINER